

REMARKS

Claims 1-9 are pending in the patent application identified above. In the office action mailed January 12, 2006, the claims were finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. pre-grant publication number 2005/0009527 to Sharma (*Sharma*) and U.S. pre-grant publication number 2004/0114574 to Zeira (*Zeira*).

Claims 1 and 6 are independent. Claim 1 is directed to a method of performing a cell update in a “user equipment” device. Claim 6 is directed to a device that performs the steps recited in claim 1.

As stated in paragraph [0008], the application and its claims are directed to ambiguities in various wireless communications standards, including the Third Generation Partnership Project or 3GPP standard, one of which is what happens in a “user equipment” or “UE” when an “event” occurs while a reconfiguration procedure is underway in a UE. Claims 1 and 6 respectively cover an inventive method and an apparatus to resolve what happens in a UE when an “event” occurs while a reconfiguration procedure is underway in user equipment.

Paraphrased, both of claims 1 and 6 require a user equipment device to receive a reconfiguration command from a network. As the claims are drafted, the reconfiguration command must include a specified time when the reconfiguration command is to be applied. The claims also recite that when a “trigger event” is detected by the user equipment, a reconfiguration procedure is cancelled in response to the trigger event’s detection.

Under current USPTO examination guidelines, in order to establish *prima facie* obviousness, a claim rejection under §103(a) must satisfy three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim’s limitations.

Importantly, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on an applicant's disclosure.¹

The rejection of claims 1 and 6 under §103(a) does not satisfy any of the USPTO's criteria. In fact, the only reason given by the Examiner to combine *Sharma* with *Ziera* is that the two references are in "analogous" fields of endeavor, which is not a USPTO-recognized reason for combining references to find a claim to be obvious.² In other words, the Examiner's stated reason for combining the references does not satisfy even the USPTO's test of obviousness.

For reasons set forth below, no one of ordinary skill in the art would have any reason to combine *Sharma* with any other reference to come up with the subject matter claimed in this application.

Like the pending application, *Sharma* pertains to Universal Mobile Telecommunications Systems (UMTS). Like the pending application, *Sharma* also pertains to the reconfiguration of "user equipment" used in a UMTS.

The *Sharma* reference has approximately 108 paragraphs of specification text. Approximately seventy of them, i.e., paragraphs [0004] through [0074], pertain to what happens in a UE after the UE receives a reconfiguration command. In paragraph [0074], *Sharma*, plainly states that it would be "desirable, to provide a ... [user equipment] that has a connection mode configuration that includes a transition state to implement transitioning to a duplex state where a temporary identifier is supplied to facilitate duplex communications in the duplex state" in order to overcome the 3GPP ambiguities. In paragraph [0083], *Sharma* succinctly states that user equipment should transition from the monitoring state to the duplex state, via a particular transition state. Thus, *Sharma* proposes a specific way for UE equipment to operate, which is

¹ See MPEP §706.02(j)

² See paragraph 5 on page 4 of the office action.

described in paragraphs [0098] through [0106]. Since *Sharma* purports to resolve a specific problem with a specific solution, there is no reason why any one of ordinary skill in the art would ever be motivated to consider any other reference, i.e., any *other* way of configuring or operating a UE in a 3GPP network.

In the office action, the Examiner selectively extracted various limitations of the pending claims from *Sharma* but ignored other teachings of *Sharma*, which teach away from the invention recited in the pending claims. Note that the Examiner provided absolutely no reason why someone of ordinary skill in the art would pick and choose some limitations from *Sharma*, yet ignore other explicit teachings of *Sharma*, in particular, the teachings of paragraphs [0083] and [0098] - [0106]. Instead of recognizing what *Sharma* teaches in its entirety, the Examiner *sua sponte* selectively extracted bits and pieces of *Sharma*, and combined those pieces of *Sharma* with various teachings of *Ziera* in order to find the pending claims to be obvious, for sole reason that *Sharma* and *Ziera* are from “analogous fields of endeavor.”

That someone of ordinary skill in the art would supposedly combine *Sharma* with *Ziera* solely because they are from “analogous fields of endeavor” is not a proper reason to combine the two references. The rejection of claims 1 and 6 should be withdrawn.

Notwithstanding the impropriety of the Examiner’s rejections, claims 1 and 6 have been amended to further distinguish the applicant’s invention from the prior art. Both of claims 1 and 6 have been amended recite that a failure flag is set after the reconfiguration procedure is cancelled. The claims also require a configuration failure message to be sent from the UE after the cell update procedure is completed.

Support for the amendments to claims 1 and 6 can be found in paragraph [0045] of the pending application. Support for the amendments can also be found in FIG. 11. No new matter has been added.

As set forth above, when a claim rejection under §103(a) is based on a combination of references, the combination of references must teach all of the claim's limitations. Even *if* there were some motivation to combine the two cited references, neither of them show or suggest the limitations that have been added to claims 1 and 6 by this amendment. The rejections under 35 U.S.C. §103(a) have therefore been traversed and the claims are now in condition for allowance.

Since claims 1 and 6 are in condition for allowance, claims that depend from claims 1 and 6 are also in condition for allowance. Reconsideration of the claims is respectfully requested.

Respectfully submitted,

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